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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,041	12/21/2001	Robert Lee	56829US002	3159

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3M INNOVATIVE PROPERTIES COMPANY  
PO BOX 33427  
ST. PAUL, MN 55133-3427

EXAMINER

THANH, LOAN H

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/028,041

Applicant(s)

LEE ET AL.

Examiner

LoAn H. Thanh

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-14, 17 and 20-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15, 16, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of group III in Paper No. 6 is acknowledged.

The traversal is on the ground(s) that the group of claims are interrelated , a search and examination of the prior art relevant to group I and II will involve the same analysis for the device group and that it would be undue burden to the by requiring payment for separate filing, prosecution and maintenance fees. This is not found persuasive because classification in different subclasses was created to differentiate and separate the different patentable subject matter, the analysis for the search and examination would be different since method claims are treated differently than apparatus claims, and further applicant is allowed one invention for each application filed. It is the Examiner's position that applicant has 3 separate inventions. The Examiner has shown that the device can be used in a materially different process of using that product.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-14, 17, 20-23 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

An action on the merits now follows.

Art Unit: 3763

### ***Specification***

The specification has been checked, however it has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description reference numeral 18a, 18b, and 32

or they include the following reference sign(s) not mentioned in the drawings: reference numeral 18.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3763

Claims 15-16,18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Etherington (U.S. Patent No. 4,660,569).

Etherington discloses a self venting seal and plunger system comprising a hollow cylindrical body 25, a movable seal 15 comprising a plunger pocket tip , a vent 20a, and a plunger tip comprising at least one vent channel. It is the Examiner's position is that when the plunger is not yet fully seated in the movable seal the vent opening in the movable seal is occluded due to the resiliency of the seal material. Once the plunger is fully seated the plunger tip is configured to lock into the plunger tip pocket of the seal. As is readily shown in figures 1-8, the second end of the seal is a concave surface and the vent is located in the center of the concave surface.

Claims 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Bailey (U.S. Patent No. 4,257,426).

Bailey discloses a self venting seal and plunger system comprising a hollow cylindrical body , a movable seal 28 comprising a plunger pocket tip 29, a vent 32, and a plunger tip comprising at least one vent channel.

Claims 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Schwartz (U.S. Patent No. 3,566,859).

Schwartz discloses a self venting seal and plunger system comprising a hollow cylindrical body 20 , a movable seal comprising a plunger pocket tip , a vent 34, and a plunger tip comprising at least one vent channel.

Claims 15,16 are rejected under 35 U.S.C. 102(b) as being anticipated by Marzolf et al. (U.S. Patent No. 4,615,341).

Art Unit: 3763


Marzolf et al. disclose a self venting seal and plunger system comprising a hollow cylindrical body 12 , a movable seal 32 comprising a plunger pocket tip , a vent 60, and a plunger tip comprising at least one vent channel 56.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LoAn H. Thanh whose telephone number is 703-305-0038. The examiner can normally be reached on Mon-Fri (alternate Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703) 308-3552. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

  
LoAn H. Thanh  
Primary Examiner  
Art Unit 3763

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